



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,889	02/16/2001	Richard Joseph Bennett	340005-2012	5194

20999 7590 01/30/2009
FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

EXAMINER

NAJARIAN, LENA

ART UNIT	PAPER NUMBER
----------	--------------

3686

MAIL DATE	DELIVERY MODE
-----------	---------------

01/30/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD JOSEPH BENNETT, ALBERT A. TATE,
DAVID ANDREW RAPPERPORT, RYAN MICHAEL EASTMAN,
and RANDALL SCOTT DEBOLD

Appeal 2008-1903
Application 09/784,889
Technology Center 3600

Decided: ¹January 29, 2009

Before: MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
STEVEN D.A. McCARTHY, *Administrative Patent Judges.*

McCARTHY, *Administrative Patent Judge.*

DECISION ON APPEAL

¹ The two month time period for filing an appeal or commencing a civil action, as recited in 37 CFR § 1.304 (2008), begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or the Notification Date (electronic delivery).

STATEMENT OF THE CASE

1 The Appellants appeal under 35 U.S.C. § 134 (2002) from the final
2 rejection of claims 26-34, 49-55 and 60-63 under 35 U.S.C. § 102(b) (2002)
3 as being anticipated by Schurenberg (US 2001/0051880 A1, publ. Dec. 13,
4 2001). Oral hearing was held on October 22, 2008. We have jurisdiction
5 under 35 U.S.C § 6(b) (2002). We AFFIRM the rejection of claims 26, 33,
6 34, 49-55, 60 and 63. We REVERSE the rejection of claims 27-32, 61 and
7 62.

8 Claim 26 is typical of the claims on appeal:

9
10 26. In a computer network including a client
11 computer and a central computer, a method of
12 receiving an order of a laboratory test of a
13 biological specimen for a patient comprising the
14 steps of:
15 receiving, at the central computer, at least
16 one query transmitted through the network
17 from the client computer, the at least one
18 query including a laboratory test request and
19 patient, billing, and diagnosis information
20 corresponding to the requested laboratory
21 test;
22 and
23 transmitting information through the
24 network from the central computer to the
25 client computer, the information including
26 data for generating a test requisition and a
27 label for use with the biological specimen.
28

29 Schurenberg discloses a health data network including electronically
30 connected healthcare businesses. The network includes sites associated with
31 physician's offices, laboratories and the like. (Schurenberg 2, ¶ 0035). The

1 network enables a user to electronically place a lab order at a healthcare site
2 such as a physician office or a hospital. (Schurenberg 4, ¶ 0059). The
3 network includes a “client object server.” Schurenberg describes the client
4 object server as providing an interface which client applications may use to
5 submit laboratory orders and retrieve laboratory results. (Schurenberg 3,
6 ¶ 0040).

8 ISSUES

9 The Appellants group claims 26, 33, 34, 49-55, 60 and 63 for
10 purposes of this appeal. We select claim 26 as being representative of the
11 group. 37 C.F.R. § 41.37(c)(1)(vii) (2008). The Appellants contend that
12 Schurenberg fails to disclose:

13 structure which one of ordinary skill in the art would
14 recognize to be a “central computer;” and
15 a step of transmitting information, including data for
16 generating a test requisition and a label for use with a biological
17 specimen, from the central computer to the client computer.
18 (App. Br. 4-5). The Examiner finds that Schurenberg’s client object server
19 is a central computer. (*see* Ans. 11). The Examiner further finds that
20 Schurenberg discloses information transmission from the client object server
21 to the client computers. The Examiner interprets claim 26 to require no
22 more than the transmission of information including particular types of data
23 and not to require the actual use of this information to generate either a test
24 requisition or a label. (Ans. 11-12).

1 Claims 28-32 depend from claim 27 and claim 62 depends from claim
2 61. Claim 27 recites the step of analyzing the at least one query at the
3 central computer to verify that the requested laboratory test is payable by a
4 reasonable party identified in the billing information. Claim 61 recites a
5 computer readable medium including computer program instructions for
6 causing the central computer to perform this step. The Examiner finds that
7 Schurenberg expressly discloses verification of patient insurance eligibility
8 as well as the identification of guarantors in lab requisitions. (Ans. 12). The
9 Appellants contend that Schurenberg fails to verify patient insurance
10 eligibility or to verify guarantors by analyzing a query *at the client object*
11 *server*. (App. Br. 9; Record of Oral Hearing² at 9, ll. 15-22).

12 The appeal raises the following issues:

13 Have the Appellants shown that the Examiner erred in concluding that
14 the term “central computer” is broad enough to encompass Schurenberg’s
15 client object server?

16 Have the Appellants shown that the Examiner erred in finding that
17 Schurenberg discloses transmitting information including data for generating
18 a test requisition and a label for use with the biological specimen from the
19 central computer to the client computer?

20 Have the Appellants shown that the Examiner erred in finding that
21 Schurenberg discloses the step of analyzing the at least one query at the
22 central computer to verify that the requested laboratory test is payable by a
23 responsible party identified in the billing information?

² Record of Oral Hearing held October 22, 2008, mailed December 18, 2008.

FINDINGS OF FACT

The record supports the following findings of fact (“FF”) by a preponderance of the evidence.

1. Each site in Schurenberg’s health data network utilizes a computer system. (Schurenberg 2, ¶ 0036).

2. The computer systems associated with the various sites may interact with the client object server. (Schurenberg 3, ¶¶ 0038 and 0040). Figs. 3 and 4 of Schurenberg appear to show the client object server as being central in the sense that all data flows between the client applications and the service provider modules pass through the client object server. (*See also* Schurenberg 3, ¶ 0047 and 4, ¶ 0050 (describing communications between the client object server, on the one hand, and the client applications and service providers, on the other, without describing direct communications between the client applications and the service providers)).

3. Schurenberg describes the client object server as performing the functions of a middleware server and as providing a single standard interface for all of the various client applications. (Schurenberg 3, ¶ 0040).

4. In order to create a requisition for one or more laboratory tests, a user enters lab requisition information into one or more user interfaces generated by a client computer. The lab requisition information includes billing information and information specifying a patient. (Schurenberg 4, ¶ 0052; 5, ¶ 0089). When the requisition is created, the requisition is given a requisition number. (Schurenberg 5, ¶ 0080).

5. The client application transmits the requisition to the client object server. The client object server forwards the lab requisition

1 information to computer systems at sites serving one or more laboratories.
2 The client object server also receives the laboratory results from the one or
3 more laboratories. The client object server routes the test results to the client
4 application. (Schurenberg 3, ¶ 0041).

5 6. When the client object server routes the test results to the client
6 application, the client object server necessarily transmits to the client
7 application either information specifying the patient or the requisition
8 number so that the client application can match the results to the patient.

9 7. At the time that the lab requisition information is entered, the
10 system prints labels including information facilitating the efficient handling
11 of the specimens. (Schurenberg 4, ¶ 0055 and 6, ¶ 0104).

12 8. Schurenberg discloses that the billing information may include
13 information identifying guarantor information or information regarding a
14 payer such as an insurer. (Schurenberg 6, ¶¶ 0110 and 0111; *see also id.* 27,
15 ¶ 0623 (disclosing that a payer's billing ID is sent to a laboratory with a
16 requisition)). The reference also discloses identifying a guarantor or an
17 insurer in the patient's records. (Schurenberg 16, ¶¶ 0404 and 0406).

18 Schurenberg defines a guarantor as a party who is financially responsible for
19 the patient's medical expenses. (Schurenberg 16, ¶ 0404).

20 9. Schurenberg's system is capable of electronic verification of
21 patient insurance eligibility. (Schurenberg 2, ¶ 0027; *see also id.* 27, ¶ 0622
22 (“[C]laims and eligibility verification are examples of payer-related services
23 in the system. The system allows payers to interface with these services.”)).
24 Schurenberg discloses that an eligibility service provider may enable
25 healthcare applications to determine the healthcare insurance eligibility

1 information for a particular patient. (Schurenberg 4, ¶ 0048 and Fig. 4).
2 Schurenberg does not appear to disclose any other method for verifying
3 healthcare insurance eligibility.

4
5 PRINCIPLES OF LAW

6 “To anticipate a claim, a prior art reference must disclose every
7 limitation of the claimed invention, either explicitly or inherently.” *In re*
8 *Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). A claim under
9 examination is given its broadest reasonable interpretation consistent with
10 the underlying specification when determining whether the subject matter of
11 the claim is anticipated. *In re American Acad. of Science Tech. Ctr.*, 367
12 F.3d 1359, 1364 (Fed. Cir. 2004). In the absence of an express definition of
13 a claim term in the specification, the claim term is given its broadest
14 reasonable meaning in its ordinary usage as the term would be understood
15 by one of ordinary skill in the art. *In re ICON Health & Fitness, Inc.*, 496
16 F.3d 1374, 1379 (Fed. Cir. 2007); *In re Morris*, 127 F.3d 1048, 1054 (Fed.
17 Cir. 1997). Limitations not explicit or inherent in the language of a claim
18 cannot be imported from the specification. *E-Pass Techs., Inc. v. 3Com*
19 *Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003).

20
21 ANALYSIS

22 The Appellants have not shown that the Examiner erred in concluding
23 that the term “central computer” is broad enough to encompass
24 Schurenberg’s client object server. The Appellants assert that the Examiner
25 has not provided an express interpretation of the term “central computer” to

1 which the Appellants might respond. (Reply Br. 1-2; Record of Oral
2 Hearing at 4, ll. 23-26 and 6, ll. 12-16). The Appellants themselves have not
3 identified any specialized definition of the term “central computer” in the
4 Specification. Neither have the Appellants offered their own interpretation
5 of the term which might have aided the Examiner in determining whether
6 Schurenberg’s client object server is a “central computer.”

7 During oral argument, the Appellants’ counsel conceded that a
8 computer may be “central” in the sense that the computer is centrally located
9 in terms of the data flow. (Record of Oral Hearing at 5, ll. 10-13).

10 Schurenberg discloses that the client object server is central in the sense that
11 all data flows between the client applications and the service provider
12 modules appear to pass through the client object server. (FF 2). Therefore,
13 the reasonable scope of the term “central computer” is broad enough to
14 encompass Schurenberg’s client object server.

15 The Appellants have not shown that the Examiner erred in finding that
16 Schurenberg discloses transmitting information including data for generating
17 a test requisition and a label for use with the biological specimen from the
18 central computer to the client computer. Claim 26 recites transmitting
19 information including a particular type of data, namely, data for generating a
20 test requisition and a label for use with a biological specimen. Claim 26
21 does not recite that this transmission must be performed before the test
22 requisition and the label are generated. Claim 26 does not require that a test
23 requisition or a label be generated at all.

24 Schurenberg discloses that the client object server transmits test
25 results to the client applications. Once the client object server receives

1 laboratory results, the server may then route the orders back to the
2 originating caregiver's office. (FF 5). The laboratory results must include
3 either a requisition number or data specifying the patient so that the client
4 application can match the results with the patient. (FF 6). Therefore, the
5 laboratory results transmitted from the client object server to the client
6 application include data which also would be used for generating a test
7 requisition or a label for use with the biological specimens to be tested. (FF
8 4 and 7).

9 The Appellants have shown that the Examiner erred in finding that
10 Schurenberg discloses the step of analyzing the at least one query at the
11 central computer to verify that the requested laboratory test is payable by a
12 responsible party identified in the billing information. Schurenberg's system
13 is capable of electronic verification of patient insurance eligibility. (FF 9).
14 The analysis which verifies the patient insurance eligibility appears to be
15 performed by an eligibility service provider at an eligibility server rather
16 than at the client object server, however. (*Id.*) Schurenberg discloses that a
17 lab requisition may include billing information identifying a responsible
18 party such as a guarantor or a third part payer such as an insurer. (FF 8).
19 Information identifying a guarantor or an insurer may also be entered into a
20 patient's records. (*Id.*) Neither of these disclosures describes performing an
21 analysis, much less an analysis at the client object server.

1 CONCLUSIONS

2 The Appellants have not shown that the Examiner erred in concluding
3 that the term “central computer” is broad enough to encompass
4 Schurenberg’s client object server.

5 The Appellants have not shown that the Examiner erred in finding that
6 Schurenberg discloses transmitting information including data for generating
7 a test requisition and a label for use with the biological specimen from the
8 central computer to the client computer.

9 The Appellants have not shown that the Examiner erred in rejecting
10 claims 26, 33, 34, 49-55, 60 and 63 under § 102(e) as being anticipated by
11 Schurenberg.

12 The Appellants have shown that the Examiner erred in finding that
13 Schurenberg discloses the step of analyzing the at least one query at the
14 central computer to verify that the requested laboratory test is payable by a
15 responsible party identified in the billing information.

16 The Appellants have shown that the Examiner erred in rejecting
17 claims 27 and 61 under § 102(e) as being anticipated by Schurenberg. The
18 Appellants likewise have shown that the Examiner erred in rejecting
19 dependent claims 28-32 and 62 under § 102(e).

20
21 DECISION

22 We AFFIRM the rejection of claims 26, 33, 34, 49-55, 60 and 63.

23 We REVERSE the rejection of claims 27-32, 61 and 62.

24 No time period for taking any subsequent action in connection with
25 this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.

1 § 1.136(a)(1)(iv) (2007).

2

3

AFFIRMED-IN-PART

4

5

6

7

8

9

10

11

12

13

14 LV:

15

16 FROMMER LAWRENCE & HAUG

17 745 FIFTH AVENUE- 10TH FL.

18 NEW YORK, NY 10151